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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/750,800	12/28/2000	John A. Schlack	T721-20	8297

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TECHNOLOGY, PATENTS AND LICENSING, INC./PRIME
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EXAMINER	
MANNING, JOHN	
ART UNIT	**PAPER NUMBER**
2614	

DATE MAILED: 01/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/750,800	SCHLACK, JOHN A.	
	Examiner	Art Unit	
	John Manning	2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 62-71 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 62-71 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 9/8/05.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to the amended claims have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 62-64, 68-69 and 71 are rejected under 35 U.S.C. 102(e) as being anticipated by Hinderks (US Pat App Pub No 2001/0025377).

In regard to claim 1, Hinderks discloses a system and method where "[l]ocal commercials and/or other IP digital data may be inserted into the received IP digital data stream at the remote Internet POP. The IP digital data signal stream received at the POP may also be stored and/or delayed at the POP for later playback and broadcasting/multicasting to recipients having a computer or other IP data receiving equipment connected to the Internet but distal from the POP" (Abstract). The claimed limitation of "defining a plurality of market segments" is met by the local commercials, which correspond to geographic market segments. The claimed limitation of

"generating a set of presentation streams corresponding to a programming channel having programming data, each of the presentation streams in the set corresponding to a different one of the plurality of market segments, each of the presentation streams in the set carrying the same programming data as the programming channel and at least one advertisement directed to the market segment 'to which the presentation stream corresponds, wherein the presentation streams are generated' independent of a request for the programming channel by the subscribers". The claimed limitation of "simultaneously delivering the set of presentation streams to a switching device" is met by Figure 3, Items 1020, 1008 and 1024. The claimed limitations of "receiving at the switching device a first request for the programming channel from a first subscriber in a first market segment", "switching a first presentation stream corresponding to the first market segment from the set of presentation streams to the first subscriber; (9 receiving at the switching device a second request for the programming channel from a second subscriber in a second market segment" and "switching a second presentation stream corresponding to the second market segment from the set of presentation streams to the second subscriber" are met by Figure 35, Item 1024. "Referring now to FIG. 35, the architecture depicted illustrates how a multicast network 1000 may be combined with the Internet network 1001 to form a powerful local content insertion system. Using this architecture, Local Server 1020 can output either stream 1002, 1004, or 1006 based on the local event trigger. The output 1008 of 1020 is a multicast stream and is input to router 1024 where it is combined with input from the Internet 1001. The combined signals are then routed to the appropriate "viewers" 1026 or 1027 depending on their

requests. Connection 1008 may be a one-way (i.e., no back channel) UDP-only connection, thus carrying only IP multicast traffic, or it may be a two-way TCP link, which can also transmit UDP data. If it is a two-way link, then local server 1020 can control and/or be controlled by external devices whose input flows from router 1024. In this example system, content viewers (1026, 1027) may, for example, be standard Internet browsers viewing web pages with embedded audio/video plugins. The HTML web pages may be delivered via the Internet 1001 in the conventional manner using TCP/IP links. A separate multicast video/audio network 1000 provides the video/audio content to the local server where it is either passed to the router or an alternate local stream is substituted. The viewers (1026, 1027) may also be stand-alone media players that interact with the Internet 1001 to receive program guide information and interact with the multicast network 1000 to receive multicast audio and/or video information" (Paragraphs 0219-0220).

In regard to claim 63, as mentioned above, the transmission is multicast, which is inherently simultaneous.

In regard to claim 64, the claimed limitations of "generating a schedule of advertisements to be included in the presentation streams for each market segment" and "storing a library of advertisements to be included in the presentation streams in the set" are met by server 1020. Local server 1020 replaces existing advertisements base on the market segment, where the schedule is based on the user location.

In regard to claim 68, Hinderks discloses "inserting the advertisements into the respective presentation streams in the set based on scheduled avail times in the presentation streams" (See Paragraphs 0201-0202).

In regard to claim 69, Hinderks discloses that the advertisement insertion is performed at the headend (Se Figure 35).

In regard to claim 71, at any given point, the geographic location of a user is fixed; therefore, a specific market segment, with respect to geography, is fixed.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 65-67 and 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hinderks.

In regard to claim 65-66, Hinderks fails to explicitly disclose the use of subscriber information and segment information identifying advertiser specific market segments in generating the advertisement schedule. However, the examiner takes OFFICIAL NOTICE that it is notoriously well known in the art to use subscriber information and segment information identifying advertiser specific market segments in generating an advertisement schedule so as to schedule the most appropriate advertisement for a particular viewer segment. Consequently, it would have been clearly obvious to one of

ordinary skill in the art to implement Hinderks with the use of subscriber information and segment information identifying advertiser specific market segments in generating the advertisement schedule for the stated advantage.

In regard to claim 67, Hinderks fails to explicitly disclose detecting a cue tone present in one of the presentation streams. However, the examiner takes OFFICIAL NOTICE that it is notoriously well known in the art to detecting a cue tone present in one of the presentation streams so as to recognize the proper time to insert an advertisement. Consequently, it would have been clearly obvious to one of ordinary skill in the art to implement Hinderks with detecting a cue tone present in one of the presentation streams so as to recognize the proper time to insert an advertisement.

In regard to claim 70, Hinderks fails to explicitly disclose that the market segments are defined by different advertisers. However, the examiner takes OFFICIAL NOTICE that it is notoriously well known in the art to have market segments defined by different advertisers so as to directly allow the advertisers to choose the viewer base for their marketing scheme. Consequently, it would have been clearly obvious to one of ordinary skill in the art to implement Hinderks with market segments defined by different advertisers for the stated advantage.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Manning whose telephone number is 571-272-7352. The examiner can normally be reached on M-F: 9:00 - 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 571-272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JM
January 9, 2006

JOHN MILLER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600